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JAMES C. SCHELLER, JR.
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
SEVENTH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES CA 90025-1026

COPY MAILED

OCT 06 2004

OFFICE OF PETITIONS

In re Application of :
Ledingham, Penny, Zak, Zanin, and :
Aikins : DECISION REFUSING STATUS
Application No. 10/698,668 : UNDER 37 CFR 1.47(a)
Filed: 31 October, 2003 :
Attorney Docket No. 06486.P003 :

This is in response to the petition filed under 37 CFR 1.47(a) on 7 September, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 31 October, 2003, without an executed oath or declaration.

Accordingly, on 2 February, 2004, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 7 September, 2004 (certificate of mailing date 2 September, 2004), petitioners filed a five (5) month extension of time, the late-filing surcharge, and a declaration naming Robert

Ledingham, Keith Penny, Roman Zak, Jaff Zanin, and Howard Aikins as joint inventors and signed by all inventors except joint inventors Zak and Zanin on behalf of themselves and non-signing joint inventors Zak and Zanin.

Petitioners assert that joint inventor Penny attempted to secure the signatures of the non-signing inventors but was unable to do so.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In regards to item (1), petitioners have not provided proof that Zak and Zanin were ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ In order for a Rule 47 petition to be granted, the inventors must be afforded an opportunity to review the application.² Therefore, petitioners should send a copy of the application papers to Zak and Zanin's last known addresses. Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

¹MPEP 409.03(d).

²See In re Gray, 115 USPQ 80 (Comm'r Pat. 1956). The application papers must be sent or given to the non-signing inventor unless he or she refuses to accept delivery of the papers.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Receipt is also acknowledged of petitioners' request for a corrected filing receipt filed on 7 September, 2004. A review of Office records reveals that the requested correction has been made. A corrected filing receipt is enclosed for petitioners' records.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
~~Senior Petitions Attorney~~
Office of Petitions

cc: Corrected Filing Receipt